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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/620,021	07/20/2000	Janusz Rajski	1011-54375	3823

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EXAMINER

CHUNG, PHUNG M

ART UNIT	PAPER NUMBER
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2133

DATE MAILED: 04/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/620,021

Applicant(s)

RAJSKI ET AL.

Examiner

Phung My Chung

Art Unit

2133

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12, 6-27, 29-40, 44 and 47-60 is/are rejected.
- 7) ☒ Claim(s) 3-5, 28, 41-43, 45-46 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 17.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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1. Claim(s) 1, 6-11, 15, 18-24 and 34 of patent # 6,684,358 contain(s) every element of claim(s) 1-2, 11-39, 47-57 and 59-60 of the instant application and as such anticipate(s) claim(s) 1-2, 11-39, 47-57 and 59-60 of the instant application.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " **ELI LILLY AND COMPANY v BARR LABORATORIES, INC.**, United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-2, 11-14, 16-18, 19-21, 22-27, 29, 30-31, 34-35, 36-37, 38-39, 44, 48, 50-53, 55 and 57-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacLean, Jr. et al (5,167,034) in view of Rajski ("Test Data Decompression for Multiple Scan Designs with Boundary Scan" IEEE transactions on computer, Vol. 47, No. 11, November 1998, Pgs. 1188-1200).

As per claims 1-2, 11-14, 16-18 and 40, MacLean, Jr. et al disclose the invention substantially as claimed, comprising the steps of:

Providing a compressed test pattern of bits;

Decompressing the compressed test pattern into a decompressed test pattern of bits as the compressed test pattern is being provided. (See col. 17, lines 47-52 and col. 18, lines 6-8). MacLean, Jr. et al do not disclose applying the decompressed test pattern to scan chains of a circuit under test. However, Rajski et al disclose applying the decompressed test pattern to scan chains of the circuit under test. (See Abstract, pg. 1192, lines 15-19, and Fig. 6, pg. 1195, col. 2, lines 3-16). Rajski et al also disclose the compress and decompress test pattern. Therefore, it would have been obvious to a person of ordinary skill in the art, at the time the invention was made, to incorporate the step of applying the decompressed test pattern to scan chains of the circuit under test as taught by Rajski et al into the invention of MacLean, Jr. et al to minimize the area overhead, reduce the amount of test data in a cost effective manner.

As per claims 19-27, 29-39, 44, 48, 50-53, 55 and 57-58, these claims are also rejected because they dependent upon the rejected base claims.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 56 and 59-60 are rejected under 35 U.S.C. 102(b) as being anticipated by MacLean, Jr. et al (5,167,034).

As per claims 56 and 58, MacLean, Jr. et al disclose the substantially as claimed, comprising the steps of:

Inputting bits of a compressed (compacted) test pattern; and

Decompressing (decompacting) the bits of the compressed test pattern as they are received. (See col. 17, lines 47-52 and col. 18, lines 6-8).

As per claim 59, the teaching of MacLean, Jr. et al have been discussed above. MacLean, Jr. et al further disclose, wherein the inputting comprises receiving the bits of the compressed test pattern in parallel. (See col. 17, line 62).

As per claim 60, MacLean, Jr. et al further disclose generating bits of the decompressed test pattern by logically combining two or more bits of the compressed test pattern. (See col. 17, lines 58-59).

6. Claims 3-5, 28, 41-43 and 45-46 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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7. Applicant's arguments with respect to claims 1-60 have been considered but are moot in view of the new ground(s) of rejection.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phung My Chung whose telephone number is 703-305-9686. The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on 703-305-9595. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



PHUNG M. CHUNG  
PRIMARY EXAMINER